

REMARKS/ARGUMENTS

Claims 22, 24, 26 and 29-33 remain in the application.

Claims 1-21, 23, 25, 27-28 were previously canceled.

Claim 22 is in independent form.

Claims 34-36 are new. Applicants respectfully assert that the subject matter of the new claims is fully supported by the specification and drawings as originally filed at least under MPEP 2163(II)(A)(3)(a) and 2181(IV). For example, portions of Figure 4 embody subject matter claimed in new claim 34, and portions of Figures 1 and 3 embody subject matter claimed in new claims 35 and 36. Entry thereof is respectfully requested.

35 U.S.C. §102 REJECTION

Claims 22, 24, and 29-33 are rejected under 35 USC §102(e) over United States Patent No. 6,644,722 to Cooper. Applicants respectfully traverse the rejection of claims 22, 24, and 29-33 because these claims are patentably distinguishable and not anticipated by the cited reference. Applicants do not concede that the Cooper reference is actually a valid prior art reference and Applicants reserve the right to swear behind the reference at a later date.

Under MPEP 2131, the test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the claimed invention is distinguishable over the cited reference and, thus, the cited reference fails to anticipate the claimed invention. In addition to the *Lindemann* test of anticipation, the "identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants' independent claim 22 recites, *inter alia*, the following elements:

- a metal component having a closed cross section defining an exterior,
- a plastic component disposed about at least a portion of the exterior of the metal component, and
- the plastic component includes at least one integrally formed connection member having an area defining at least one connection portion formed therein and operable to receive a fastening member so as to permit the plastic component to be fastened to at least one component other than the metal component.

First, the Cooper reference discloses and shows a rigid metal support 12 (col. 3, line 15) that has a U-shaped open – not closed – cross section. Thus, the Cooper reference completely fails to disclose that the rigid support 12 has a closed cross section defining an interior and an exterior.

Second, the Cooper reference discloses and shows the metal U-shaped rigid support 12 disposed about an exterior of a plastic air duct 15, but not the other way around. In other words, although Cooper discloses that the plastic air duct 15 is disposed about various interior surfaces of the metal support 12, Cooper fails to disclose that the plastic air duct 15 is disposed about at least a portion of the exterior of the metal support 12.

Third, in the Office Action, col. 6, lines 20-27 of Cooper, are cited for disclosure of Applicants' claimed connection member and connection portion operable to receive a fastening member to permit a plastic component to be fastened to another component. But that citation to Cooper relates to fasteners 100 and adhesives 103 for attaching the plastic duct 15 to the metal support 12, and not for attaching the plastic duct 15 to at least one component other than the metal support 12.

Moreover, the Cooper reference discloses and shows that the metal support 12 includes an anchoring extension 51 used to attach the assembly 3 to a separate structure of an automobile such as an A-pillar. More specifically, the Cooper reference discloses that the metal support 12 may be threaded at edges of a perforation or that a nut may be welded to the metal support 12 over the perforation 60 to accept a bolt. (col. 7, lines 47-56) In other words, the metal support 12 – not the plastic air duct 15 – includes a connection portion to receive a fastening member so as to permit the metal support 12 – not the plastic air duct 15 – to be fastened to another component. Accordingly, Cooper fails to disclose that the plastic air duct 15 includes at least one integrally formed connection member having an area defining at least one connection portion formed therein and operable to receive a fastening member so as to permit the plastic air duct 15 to be fastened to at least one component other than the metal support 12.

Lacking not one, but several, significant elements of Applicants' independent claim 22, that claim is thereby distinguishable over the Cooper reference, which therefore cannot anticipate independent claim 22. For at least this reason, amended independent claim 22 is allowable over Cooper. Claims 24, 26, and 29-36, which ultimately depend from claim 22, are likewise allowable over Cooper. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 22, 24, and 29-34 under 35 U.S.C. §102.

35 U.S.C. §103 REJECTION

Claim 26 is rejected under 35 USC §103 over Cooper in view of United States Patent No. 6,708,583 to Palmer. Applicants respectfully traverse the 35 U.S.C. § 103 rejection set forth herein for the reason that Applicants' claimed subject matter of independent claim 22 and claim 26 is patentably distinguishable, and not obvious, in view of the cited references.

A *prima facie* case of obviousness requires a proposed combination of references to teach or suggest all elements of a rejected claim. See *CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

For at least the reasons set forth above with respect to the §102 rejection, Cooper fails to disclose or teach or suggest at least three significant elements of Applicants' claims. And neither the Office Action, nor the Palmer reference itself, demonstrates that the teachings of the Palmer reference cure the deficiencies of the Cooper reference.

Lacking not one, but several, significant elements of Applicants' independent claim 22, that claim is thereby distinguishable over any combination of the Cooper and Palmer references, which therefore cannot render obvious independent claim 22. For at least this reason, independent claim 22 is allowable over the applied references. Claims 24, 26, and 29-36, which ultimately depend from claim 22, are likewise allowable over the applied references. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 26 under 35 U.S.C. § 103.

CONCLUSION

Prosecution has now reached *ten* substantive office actions, a request for continued examination, and an Appeal, which the Examiner avoided by reopening prosecution with the present Office Action. The Examiner has now returned to a reference considered and withdrawn over *five* years ago in this case. Applicants respectfully submit that it is now clear

that no supportable rejection remains in the application and, thus, Applicants respectfully request that a notice of allowance be issued for all claims in this case.

Otherwise, per the accompanying Interview Request form, Applicants hereby respectfully request an interview with the Examiner and with the Examiner's SPE, before proceeding to Appeal.

It is believed that any additional fees due with respect to this paper have already been identified. However, if any additional fees are required in connection with the filing of this paper, the Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-0852 (Reising Ethington PC).

Any needed extension of time is hereby requested with the filing of this document.

Respectfully submitted,

Reising Ethington PC
PO Box 4390
Troy, Michigan 48099-4390
Telephone: 248-689-3500
Facsimile: 248-689-4071
Email: hoffmann@reising.com

by /Richard W. Hoffmann, Reg. No. 33711/
RICHARD W. HOFFMANN
Registration No. 33,711

Date: October 21, 2009
RWH/SBW